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10/763,374	01/23/2004	Ernst Mauch	20020/10018	7574

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GROSSMAN & FLIGHT LLC  
Suite 4220  
20 North Wacker Drive  
Chicago, IL 60606-6357

EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/763,374

Applicant(s)

MAUCH ET AL.

Examiner

Bret C Hayes

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☒ Claim(s) 19 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/16/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because line 1, "are disclosed" should be removed. Correction is required. See MPEP § 608.01(b).

### *Claim Objections*

3. Claims 19 and 21 are objected to because of the following informalities: claim 19, line 2, "an authorized user" should be --the authorized user-- as "an authorized user" is recited in the base claim; and claim 21, line 3, "a user" should be --the user--, for the same reason. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10, 12 – 16, 19, 22, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3644

6. Claim 10 recites the limitations "the electronic identification code" in lines 1 and 2, and "the magazine" in lines 2 and 3. There is insufficient antecedent basis for these limitations in the claim. Examiner notes that the claim should depend upon claim 9 instead of claim 1 and treats the claim hereafter as so depending.

7. Claim 12, lines 2 and 3, recites "a word recognition device", which is ambiguous as "a word" can be either printed or spoken.

8. Claim 19 recites the limitation "the shooter" in line 3. There is insufficient antecedent basis for this limitation in the claim.

9. Claims 22 and 26 recite the limitation "the weapon" in line 2 of each. There is insufficient antecedent basis for this limitation in the claims.

10. Claim 27 recites the limitations "the memory in the module" and "the connection" in line 3. (*Emphasis added.*) There is insufficient antecedent basis for these limitations in the claim.

Regarding the memory limitation, the base claim, claim 1, recites, beginning at line 4, "a module...containing an electronic identification device", while claim 2 recites, beginning at line 1, "a memory associated with the electronic identification device". (*Emphasis added.*) That the device is 'contained' by the module cannot inherently limit the memory 'associated with' the device to also be so contained.

Regarding the connection limitation, examiner suggests --an attachment--, since the module is recited as being removably "attachable" in the base claim.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 11 – 15, 22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,459,957 to Winer.

13. Re – claim 1, Winer discloses the claimed invention including a firearm **10** comprising: a housing having a handle **20**; a safety **48** located in the housing; and a module, *inter alia*, **40** removably attachable to the handle **20** and containing an electronic identification device (*EID*) to identify an authorized user, the *EID* controlling the safety **48**.

14. Re – claim 2, Winer further discloses a memory **39, 44** associated with the *EID*.

15. Re – claim 11, Winer further discloses a microphone **24** coupled to the *EID*.

16. Re – claim 12, Winer further discloses the *EID* comprising a voice recognition device or a word recognition device, as set forth at col. 5, line 51 (5:51).

17. Re – claims 13 and 14, Winer further discloses the voice recognition device or the word recognition device being structured to recognize a normal voice, a whisper and a hoarse voice of the user.

18. Re – claim 15, Winer further discloses the microphone **24** being connected with a memory **44** which records data indicative of spoken commands from the user – a “PIN”.

Art Unit: 3644

19. Re – claim 22, Winer further discloses the safety 48 preventing firing when the module 40 is removed from the firearm 10 – blocking lever or bar 54 maintains its position upon removal of module 40.

20. Re – claim 26, Winer further discloses a contact sensor 50 as claimed.

21. Claims 28, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,713,150 to Ealovega.

22. Re – claim 28, Ealovega discloses the claimed invention including a firearm 10 comprising a housing, as shown in FIGS. 2A – 2C, for example, an electronic component 64 located in the housing, an accumulator 70, and a generator 100, as at 5:30, as claimed.

23. Re – claim 32, Ealovega further discloses the at least one part comprising a breech or a structure that is movable with the breech – the bolt assembly, 5:32.

24. Re – claim 33, Ealovega further discloses the generator comprising a piezoelectric element so positioned.

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 17, 19 – 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winer.

27. Re – claims 17, 19, 20 and 27, Winer discloses the claimed invention including the microphone 24 being connected with the memory 44, except for (17) recording data reflecting

Art Unit: 3644

firing of shots, (19) more than one user being the authorized user and the data reflecting the firing of shots comprises an identification of the user during the firing of the shots, (20) the memory storing an event indicative of a maintenance requirement of the firearm, and (27) the firearm having an identification number, the number being written to the memory.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to record or store any such data, since the device as disclosed by Winer is capable of such, and further, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, Winer satisfies the claimed structural limitations.

28. Claims 3 – 8 and 29 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winer in view of Ealovega.

29. Re – claim 3, Winer discloses the invention substantially as claimed except for the EID being powered by current generated by movement of a first part of the firearm 10 relative to a second part of the firearm 10. Ealovega teaches current generated by first and second parts of a firearm moving relative to each other in the same field of endeavor for the purpose of powering an electronic device, as applied above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Winer to include the generator as taught by Ealovega in order to supply power to an electronic device.

30. Re – claim 4, Winer in view of Ealovega discloses the claimed invention except for the first part comprising a magnet carried by a magazine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a magnet as the first part,

Art Unit: 3644

since the equivalence of a piezoelectric element and a magnet for their use in the electrical power supplying art and the selection of any known equivalents to a piezoelectric element would be within the level of ordinary skill in the art. (Inductance is a well known and often employed electrical phenomenon involving a magnet.)

31. Re – claim 5, Winer in view of Ealovega discloses the invention substantially as claimed except for the magazine being stored in the handle, explicitly. It is obvious, if not inherent, in the firearm disclosed by Winer that the magazine would be stored in the handle.

32. Re – claims 29 – 31, Ealovega discloses the claimed invention except for the structure taught by Winer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ealovega to include the structure taught by Winer – in reverse of the above – for the purpose of supplying power. As indicated above, inductance involves a magnet. It also normally involves a coil and relative motion between the magnet and the coil.

33. Re – claims 6 – 8, Ealovega teaches the modifications to the firearm as applied above (see claims 28, 32 and 33), in the same field of endeavor for the purpose stated above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Winer to include the structure as taught by Ealovega in order to create power.

34. Claims 9, 10, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winer in view of US Patent No. 6,477,801 B1 to O'dwyer.

35. Re – claims 9 and 10, Winer discloses the invention substantially as claimed except for the firearm further comprising a magazine having an identification code which is read and recorded by the EID. O'dwyer teaches a magazine 19 having an identification code which is read and recorded by an EID 18 in the same field of endeavor for the purpose of securing



Art Unit: 3644

firearms. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Winer to include the magazine as taught by O'dwyer in order to secure a firearm.

36. Re – claim 16 and 18, Winer discloses the invention substantially as claimed except for the firearm further comprising a timer or time signal receiver, wherein the data indicative of the spoken commands comprises a firing time, and wherein the data reflecting firing of shots comprises a firing time. O'dwyer teaches a timer, beginning at 2:13 in the same field of endeavor for the purpose of providing such information upon interrogation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Winer to include the timer as taught by O'dwyer in order to provide such information.

***Conclusion***

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (703) 305 – 7421. The fax number is (703) 872 – 9306.

bh

11/4/04



**TERI P. LUU  
SUPERVISORY PRIMARY EXAMINER**